

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85486320
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In response to the Office Action ("OA") mailed this past October 22, 2012, Applicant submits the following request for reconsideration: RESPONSE RE: 2(e)(1) DESCRIPTIVENESS REFUSAL. Applicant respectfully contends that Examiner's arguments are insufficiently supported by the evidence. A review of the relevant jurisprudence clearly indicates that much of the evidence introduced by an examiner to support a finding of descriptiveness arising from a foreign term must speak to the relevant portion of the U.S. consuming public. In other words, if a cited source originates in a foreign country, its probative value is low or non-existent as it does not speak to the understanding of the term by U.S. consumers. In re Bayer Aktiengesellschaft, 2005 TTAB LEXIS 521, 8 n3 ("A common mistake of examining attorneys is submission of NEXIS excerpts originating in foreign countries. The present record includes such evidence, and these excerpts are not probative on the issue before us."). Applicant's prior responsive filing noted which of the Examiner's evidence originated in a foreign country. Those items should not be considered or be given little weight in considering what the term SUERO ORAL means to U.S. consumers. Similarly, in the Examiner's Final Office Action, Examiner cites to foreign sources, namely attachments from: 1. www.mibebecito.com (from El Salvador; see Ex. 16), 2. www.fundaciondiabetes.org (site from Spain hosting article written by a clinic in Barcelona, Spain; see Ex. 17), 3. www.linguee.es (a translation site from Germany that draws mainly on various non-U.S. sources. It is notable that the few references to U.S. sites [from Florida, Arizona and New Jersey, see Attachments 24, 26] translates "suero oral" into Suero Oral and "suero" into IV [i.e. intravenous] or serum; see Ex. 18), 4. www.comoserunkiwi.com (from Spain; see Ex. 19), 5. www.espanol.babycenter.com (Babycenter's international page for Spain), 6. www.youtube.com (the posters of these videos are from Mexico or the organization PAHO; see Ex. 20-23), and 7. www.proz.com (the discussion shows that the use of "suero oral" descriptively arises with respect to Mexico at Attachment 15). Examiner, in the body of the Final Office Action, quotes from Wikipedia language that specifically limits its discussion of "Suero Oral" to households in South and Central America and parts of the Caribbean (The U.S. is not mentioned). Simply put, these items should not be considered or, if considered, given little weight vis-a- vis Applicant's U.S.-based evidence. Furthermore, a foreign word may have multiple meanings in English. Where such a term does not have a single and unalterable significance in English, then no likelihood of confusion can be found. 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:38 at 23-168 (4th ed. 2006) (Referencing a case where likelihood of confusion was not found between PALOMA and DOVE, both for heating apparatus, because "paloma" translates to both dove and pigeon). Similarly, no equivalence</p>	

can be found for purposes of determining if the foreign word's primary meaning is descriptive if the foreign term has multiple meanings in English. It is clear from the Examiner's own evidence that SUERO translates to both "serum" and "whey." Attachment 16-18. In one source, "whey" is the first and primary translation. Attachment 16. The discussion found on proz.com shows that the translation of "Suero Oral" as whey or buttermilk received a higher peer agreement than the Mexican-based translation of "saline solution." Attachment 15. As such, Applicant proposes in the alternative that its mark's meaning cannot be descriptive because only one of its multiple meanings is arguably descriptive. In view of the foregoing response, Applicant believes that Applicant has addressed all of Examiner's objections to applicant's trademark application. The application as presently amended is deemed in condition for publication and prompt publication is respectfully requested. If for some reason the present amendment does not place the case in condition for publication, the Examiner is respectfully requested to call applicant's attorney at (305) 604-2051 to discuss any possible further amendment of the like which places the case in condition for publication, or to arrange an Examiner's amendment to put the case in condition for publication. Respectfully submitted, Amaury Cruz, Esq.

## EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<a href="#">evi_6619170234-220055120 . Ex 16 WhoIs mibebecito.pdf</a>
CONVERTED PDF FILE(S) (2 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\854\863\85486320\xml6\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\854\863\85486320\xml6\RFR0003.JPG</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	PDF's of websites showing the origin of Examiner's evidence attached to the Final Office Action.
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/amaury cruz/
<b>SIGNATORY'S NAME</b>	Amaury Cruz, Esq.
<b>SIGNATORY'S POSITION</b>	Attorney of record, Florida bar member
<b>SIGNATORY'S PHONE NUMBER</b>	305-604-2051
<b>DATE SIGNED</b>	04/22/2013
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Apr 22 22:10:25 EDT 2013
<b>TEAS STAMP</b>	USPTO/RFR-66.191.70.234-2 0130422221025389551-85486 320-5002914acecbe3e2983a7 69095f4f8a3f7e54ef6d9cd81 de4ac869fa259e9f6b-N/A-N/ A-20130422220055120829

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **85486320** has been amended as follows:

## **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

In response to the Office Action ("OA") mailed this past October 22, 2012, Applicant submits the following request for reconsideration: RESPONSE RE: 2(e)(1) DESCRIPTIVENESS REFUSAL. Applicant respectfully contends that Examiner's arguments are insufficiently supported by the evidence. A review of the relevant jurisprudence clearly indicates that much of the evidence introduced by an examiner to support a finding of descriptiveness arising from a foreign term must speak to the relevant portion of the U.S. consuming public. In other words, if a cited source originates in a foreign country, its probative value is low or non-existent as it does not speak to the understanding of the term by U.S. consumers. In re Bayer Aktiengesellschaft, 2005 TTAB LEXIS 521, 8 n3 ("A common mistake of examining attorneys is submission of NEXIS excerpts originating in foreign countries. The present record includes such evidence, and these excerpts are not probative on the issue before us."). Applicant's prior responsive filing noted which of the Examiner's evidence originated in a foreign country. Those items should not be considered or be given little weight in considering what the term SUERO ORAL means to U.S. consumers. Similarly, in the Examiner's Final Office Action, Examiner cites to foreign sources, namely attachments from: 1. [www.mibebecito.com](http://www.mibebecito.com) (from El Salvador; see Ex. 16), 2. [www.fundaciondiabetes.org](http://www.fundaciondiabetes.org) (site from Spain hosting article written by a clinic in Barcelona, Spain; see Ex. 17), 3. [www.linguee.es](http://www.linguee.es) (a translation site from Germany that draws mainly on various non-U.S. sources. It is notable that the few references to U.S. sites [from Florida, Arizona and New Jersey, see Attachments 24, 26] translates "suero oral" into Suero Oral and "suero" into IV [i.e. intravenous] or serum; see Ex. 18), 4. [www.comoserunkiwi.com](http://www.comoserunkiwi.com) (from Spain; see Ex. 19), 5. [www.espanol.babycenter.com](http://www.espanol.babycenter.com) (Babycenter's international page for Spain), 6. [www.youtube.com](http://www.youtube.com) (the posters of these videos are from Mexico or the organization PAHO; see Ex. 20-23), and 7. [www.proz.com](http://www.proz.com) (the discussion shows that the use of "suero oral" descriptively arises with respect to Mexico at Attachment 15). Examiner, in the body of the Final Office Action, quotes from Wikipedia language that specifically limits its discussion of "Suero Oral" to households in South and Central America and parts of the Caribbean (The U.S. is not mentioned). Simply put, these items should not be considered or, if considered, given little weight vis-a- vis Applicant's U.S.-based evidence. Furthermore, a foreign word may have multiple meanings in English. Where such a term does not have a single and unalterable significance in English, then no likelihood of confusion can be found. 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:38 at 23-168 (4th ed. 2006) (Referencing a case where likelihood of confusion was not found between PALOMA and DOVE, both for heating apparatus, because "paloma" translates to both dove and pigeon). Similarly, no equivalence can be found for purposes of determining if the foreign word's primary meaning is descriptive if the foreign term has multiple meanings in English. It is clear from the Examiner's own evidence that SUERO translates to both "serum" and "whey." Attachment 16-18. In one source, "whey" is the first and primary translation. Attachment 16. The discussion found on [proz.com](http://www.proz.com) shows that the translation of "Suero Oral" as whey or buttermilk received a higher peer agreement than the Mexican-based translation of "saline solution." Attachment 15. As such, Applicant proposes in the alternative that its mark's meaning cannot be descriptive because only one of its multiple meanings is arguably descriptive. In view of the foregoing response, Applicant believes that Applicant has addressed all of Examiner's objections to applicant's trademark application. The application as presently amended is deemed in condition for publication and prompt publication is respectfully requested. If for some reason the present amendment does not place the case in condition for publication, the Examiner is respectfully requested to call applicant's attorney at (305) 604-2051 to discuss any possible further amendment of the like which places the case in condition for publication, or to arrange an Examiner's amendment to put the case in condition

for publication. Respectfully submitted, Amaury Cruz, Esq.

## **EVIDENCE**

Evidence in the nature of PDF's of websites showing the origin of Examiner's evidence attached to the Final Office Action. has been attached.

### **Original PDF file:**

[evi\\_6619170234-220055120\\_.Ex\\_16\\_WhoIs\\_mibebecito.pdf](#)

**Converted PDF file(s)** (2 pages)

[Evidence-1](#)

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**Converted PDF file(s)** (1 page)

[Evidence-1](#)

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /amaury cruz/ Date: 04/22/2013

Signatory's Name: Amaury Cruz, Esq.

Signatory's Position: Attorney of record, Florida bar member

Signatory's Phone Number: 305-604-2051

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85486320



Internet Transmission Date: Mon Apr 22 22:10:25 EDT 2013

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Registrar: GODADDY.COM, LLC  
Whois Server: whois.godaddy.com  
Referral URL: http://registrar.godaddy.com  
Name Server: NS1.CREADIGITAL.COM  
Name Server: NS2.CREADIGITAL.COM  
Status: clientDeleteProhibited  
Status: clientRenewProhibited  
Status: clientTransferProhibited  
Status: clientUpdateProhibited  
Updated Date: 28-mar-2011  
Creation Date: 27-apr-2009  
Expiration Date: 27-apr-2014

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Registered through: GoDaddy.com, LLC (<http://www.godaddy.com>)  
Domain Name: MIBEBECITO.COM  
Created on: 27-Apr-09  
Expires on: 27-Apr-14  
Last Updated on: 28-Mar-11

Registrant:  
Importadora Avash Bendek, S.A. de C.V.  
Calle Xochiquetzal # C-2  
Cumbres de Cuscatlan  
Antiguo Cuscatlan, 01000  
El Salvador

Administrative Contact:  
Avash, Farid Alberto [favash@yahoo.com](mailto:favash@yahoo.com)  
Importadora Avash Bendek, S.A. de C.V.  
Calle Xochiquetzal # C-2  
Cumbres de Cuscatlan  
Antiguo Cuscatlan, 01000  
El Salvador  
(503) 7890-0281

Technical Contact:  
Avash, Farid Alberto [favash@yahoo.com](mailto:favash@yahoo.com)  
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Page 1 of 2

Antiguo Cuscatlan, 01000  
El Salvador  
(503) 7890-0281

Domain servers in listed order:  
NS1.CREADIGITAL.COM  
NS2.CREADIGITAL.COM

related domain names

[godaddy.com](#)   [creadigital.com](#)   [yahoo.com](#)

Domains

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View Domain Pricing  
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Name Server:  
DNSSEC:Unsigned

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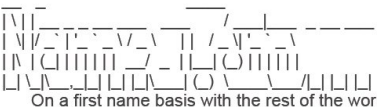
### comoserunkiwi.com registry whois

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Domain Name: COMOSERUNKIWI.COM  
Registrar: NAME.COM LLC  
Whois Server: whois.name.com  
Referral URL: http://www.name.com  
Name Server: NS1DHL.NAME.COM  
Name Server: NS2HKT.NAME.COM  
Name Server: NS3CJL.NAME.COM  
Name Server: NS4CJP.NAME.COM  
Status: clientTransferProhibited  
Updated Date: 06-jan-2013  
Creation Date: 10-jan-2012  
Expiration Date: 10-jan-2014

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Get your [domains](http://www.name.com) at Name.com.

Domain Name: comoserunkiwi.com  
Registrar: Name.com LLC

Expiration Date: 2014-01-10 11:12:58  
Creation Date: 2012-01-10 11:12:58


Name Servers:  
ns1dhl.name.com  
ns2hkt.name.com  
ns3cjl.name.com  
ns4cjp.name.com

REGISTRANT CONTACT INFO  
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View Domain Pricing	Windows Hosting	Hosting Security	Contact Support	
Bulk Domain Register	Linux Reseller Hosting	24 x 7 Servers Monitoring	Report Abuse	
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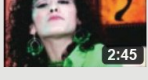


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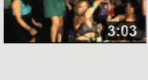


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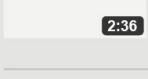


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


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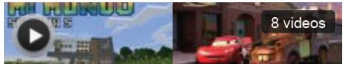
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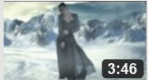
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
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
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
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
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
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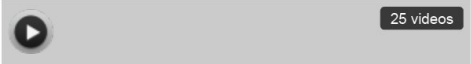
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